

REMARKS/ARGUMENTS

Upon entry of this Amendment, claims 1-3, 5, 8-18, and 21-36 will be pending of which claims 1 and 3 are independent. Claim 1 has been amended to include the features of claims 4 and 6 and, consequently, claims 4 and 6 have been cancelled. Furthermore, claim 20 has been cancelled in view of the Restriction Requirement. Consequently, no new matter has been introduced, no additional claims have been added, and no new issues have been raised. Accordingly, entry of this Amendment is respectfully requested as it is believed to place the application in condition for allowance and/or better condition for Appeal.

Preliminarily, regarding the Restriction Requirement, Applicants affirm the election of Group I, claims 1-19 and 21-35.

Furthermore, Applicants gratefully acknowledge the allowance and/or indication of allowable subject matter in claims 3, 9, and 21-35.

Claims 1, 4-5, 8, 10, 12-13, and 15-18 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,834,393 to Jacobsen *et al.* ("Jacobsen '393"). Furthermore, claims 1, 4-5, 8, 10, 12-13, and 15-18 stand rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over U.S. Patent 6,506,866 to Jacobsen *et al.* ("Jacobsen '866").¹

Applicants note that the above rejections do not concern claim 6. Accordingly, for at least the reason that claim 6 has been incorporated into claim 1 per the above amendments, it is respectfully submitted that the above rejections are moot.

Claims 2, 6, 11, and 14 stand rejected under 35 U.S.C. 103(a) as being obvious over Jacobsen '393 and Jacobsen '866. Applicants respectfully traverse these rejections for at least the following reasons.

¹ Applicants note that the Examiner refers in the first line of paragraph 11 of the outstanding Office Action to Jacobsen '393 and not Jacobsen '866. However, from e.g. the Examiner's reference to "Example 1 of col. 41", it is assumed that the Examiner intended to cite Jacobsen '866.

The Examiner acknowledges that Jacobsen '393 and '866 do not teach claim 6 and, thus, do not teach instant claim 1. However, the Examiner seems to take the position that it would be obvious to prepare "ethylene copolymer with molecular weight at [sic] high end of the range 100,000 to 1,000,000 g/mol". In this regard, Applicants note that the instantly claimed upper range is 700,000 g/mol and, thus, markedly under the "high end of the range 100,000 to 1,000,000 g/mol". Also, it is not clear to Applicants where the Examiner finds support in Jacobsen '866 for the cited range "100,000 to 1,000,000 g/mol" and clarification is respectfully requested.

In addition, the Examiner uses the Comparative Examples in Table 1 of the present application in an attempt to support the contention that polyethylenes at the "high end of the range 100,000 to 1,000,000 g/mol" are "expected to have [sic] wear coefficient of less than $2.9 \times 10^{-4} \text{ mm}^3/\text{mN}$." Besides the fact that this use of data in the present application by the Examiner appears to be improper hindsight reconstruction, the Comparative Examples furthermore have weight average molecular weights in excess of 2,000,000 g/mol and are, thus, well outside the "high end of the range 100,000 to 1,000,000 g/mol." Use of these Comparative Examples to support the Examiner's contention is, thus, inappropriate.

Finally, Applicants respectfully submit that the disclosures of Jacobsen '393 and '866 are absent any reasonable expectation of improved wear properties for polyethylenes satisfying the criteria of claim 1. It is respectfully submitted that Jacobsen '393 and '866 do not render claim 1 obvious -- much less the claims dependent thereon.

For any and all of the above reasons, it is respectfully submitted that the present invention is patentable.

Furthermore, regarding paragraph 13 of the outstanding Office Action, Applicants kindly note that no §112 rejections were set forth in the outstanding Office Action and it is assumed that the Examiner intended to mention that claim 9 would be allowable "if rewritten in independent form".


Finally, Applicants acknowledge receipt with the outstanding Office Action of a Form PTO-892 listing the above-mentioned Jacobsen Patents. However, Applicants kindly reiterate that a Form PTO 892 listing the Examiner's search results for the Office Action mailed August 5, 2003, has not yet been received, neither have Applicants yet received an initialed copy of Applicants' Form PTO-1449 dated September 23, 2002. Copies thereof are herewith kindly requested.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: 
Richard A. Steinberg
Registration No. 26,588
Direct No. (703) 905-2039

Paul L. Sharer
Registration No. 36,004
Direct No. (703) 905-2180

PLS/wdw
PO Box 10500
McLean, VA 22102
(703) 905-2000 Telephone
(703) 905-2500 Facsimile

Date: 21 January 2004